

REMARKS

I. Status of the Claims

Claims 1-19, 31-35, 44-45, 48-66, and 71-89 are pending and stand rejected. Without prejudice or disclaimer, claims 20-30, 34-43, 46-47, and 67-70 have been canceled. Claims 1, 31-33, 44, 45, 48, 49, 79, 84, and 89 have been amended herein. Support for these amendments can be found in the specification and claims as-filed. For example, the amendments to claims 1, 74, 84, and 89 are based on original claim 30, which is now canceled. Accordingly, no new matter has been added.

II. Rejection Under 35 U.S.C. § 102

The Examiner rejects claims 1-32, 44-46, and 50-89 under 35 U.S.C. § 102(b) as allegedly “being anticipated by Cottard et al. (US 2001/0023514 A1)” (“Cottard”). Office Action at 2. In particular, the Examiner asserts, in part, that Cottard “teaches a composition for oxidation dyeing of hair comprising oxidation bases . . . at least one associative polymer . . . cellulose thickeners (nonionic cellulose-based compounds) chosen from hydroxyethylcellulose and hydroxypropylcellulose . . . [and] cationic polymers of dimethyldiallylammonium [sic] chloride homopolymers.” *Id.* at 2-3. The Examiner further asserts that Cottard “teaches a process for oxidation dyeing of keratin fibers and a multi-compartment device comprising the dyeing composition as described above and as claimed.” *Id.* at 3. Thus, the Examiner concludes that Cottard “teaches all the limitations of the instant claims.” *Id.* at 4.

Applicants respectfully traverse this rejection as Cottard does not anticipate the present claims. “A claim is anticipated only if each and every element **as set forth in the claim** is found . . . in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co.*

of California, 814 F.2d 628, 631 (Fed. Cir. 1987) (emphasis added). Further, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). See also M.P.E.P. § 2131. Additionally, a compound or composition of matter can only be anticipated if the disclosure of a single reference places the compound or composition in possession of the public. See *In re Brown*, 329 F.2d 1006, 1011 (C.C.P.A. 1964). Finally, the reference must “clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound **without any need for picking, choosing, and combining various disclosures . . .**” *In re Arkley*, 455 F.2d 586, 587 (C.C.P.A. 1972) (emphasis added).

Claim 1 of the present invention recites:

A composition for the oxidation dyeing of keratin fibers comprising, in a medium suitable for dyeing:

- a) at least one oxidation dye,
- b) at least one cationic associative polymer chosen from quaternized celluloses modified with groups comprising at least one fatty chain, quaternized hydroxyethylcelluloses modified with groups comprising at least one fatty chain and cationic polyurethanes,
- c) at least one nonionic cellulose-based compound **not comprising a C₈-C₃₀ fatty chain**, and
- d) at least one cationic polymer with a charge density of greater than 1 meq/g and **not comprising a C₈-C₃₀ fatty chain**.

Claim 1 as-amended (emphasis added). In contrast, Cottard teaches an oxidation dyeing composition comprising “(1) at least one oxidation dye, (2) at least one thickening polymer comprising at least one fatty chain, and (3) at least one fatty alcohol chosen from monoglycerolated and polyglycerolated fatty alcohols.” Cottard at page 1,

paragraph [0007]. The “at least one thickening polymer comprising at least one fatty chain,” of Cottard, which the Examiner cites as teaching element b), the at least one associative polymer of the present claims, can also be chosen from nonionic celluloses **comprising C8-C22 alkyl groups**, as well as cationic quaternized celluloses **comprising at least 8 carbon atoms**, neither of which are in compliance with the present claims. See Cottard at page 4, paragraphs [0077]-[0079], and page 5, paragraphs [0101]-[0103]. Moreover, Cottard teaches nonionic and anionic polymers, whereas the at least one associative polymer of the present invention must be **cationic**. See Cottard at page 3, paragraphs [0040]-[0074] and at page 4, paragraphs [0075]-[0096]

Further, the Examiner cites obscure sections of Cottard as teaching elements c) and d) of the present claims, despite the fact that these sections do not clearly teach or suggest the claimed elements. For example, Cottard states that the “ready-to-use composition . . . **may eventually** comprise . . . at least one other agent for adjustment of rheology, such as . . . hydroxyethylcellulose, hydroxypropylcellulose” Cottard at page 17, paragraph [0340] (emphasis added). Such a passage does not teach the claimed genus of “at least one nonionic cellulose-based compound **not comprising a C₈-C₃₀ fatty chain**.” This passage of Cottard can hardly be said to teach the claimed composition of claims 1 and 4-7, as asserted by the Examiner, without impermissible picking and choosing.

In addition, by asserting that Cottard teaches “cationic polymers of dimethyldiallylammonium [sic] chloride homopolymers,” the Examiner ignores the fact that the mention of these homopolymers in Cottard is located in an **eight page**

discussion of cationic and amphoteric polymers that may optionally be present in the compositions of Cottard. See Cottard at page 8, paragraph [0166] to page 16, paragraph [0315]. Again, this eight-page passage of Cottard cannot be said to teach the claimed composition of claims 1 and 8-12, as asserted by the Examiner, without impermissible picking and choosing on the part of the Examiner.

Finally, the Example of Cottard does not teach a composition as claimed at least because it does not comprise at least one cationic associative polymer as claimed, nor does it comprise at least one nonionic cellulose-based compound not comprising a C₈-C₃₀ fatty chain. See Cottard at page 19, paragraph [0371]. Thus Cottard cannot be construed as teaching presently claimed elements b), c) and d) individually, and further Cottard cannot be said to teach these elements in combination with each other, let alone further in combination with at least one oxidation dye, and at least one associative polymer as claimed.

“An anticipating reference must describe the [claimed] subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was **recognized by persons of ordinary skill in the field of the invention.**” *ATD Corp. v. Lydall Inc.*, 48 USPQ2d 1321, 1328 (Fed. Cir. 1998) (emphasis added) (citations omitted). As demonstrated, the present invention could not have been and was not recognized in Cottard’s disclosure by persons of ordinary skill in the art. Accordingly, as shown above, the disclosure of Cottard does not put one of ordinary skill in the art in possession of the presently claimed invention. Thus, this rejection is in error and Applicants respectfully request its withdrawal.

II. Rejection under 35 U.S.C. § 103(a)

A. Claims 33-43 and 47

The Examiner rejects claims 33-43 and 47 under 35 U.S.C. § 103(a) as allegedly “being unpatentable over Cottard . . . in view of Laurent et al. (US 2002/0046431 A1)” (“Laurent”). Office Action at 4. The Examiner admits that “[t]he instant claims differ from the reference by reciting specific species of cationic polyurethane as an associative cationic polymer.” *Id.*

The Examiner cites Laurent to cure the deficiencies of Cottard, contending that Laurent, “in analogous art of hair dyeing formulation, teaches a composition comprising a cationic polyurethane of a formula (Ia), which is similar to the claimed formula (Ia) as claimed in claims 33-36 and 47.” *Id.* (citing Laurent at page 3, paragraphs [0096]-[0105]). The Examiner concludes that “one having ordinary skill in the art at the time the invention was made would be motivated to modify the composition of Cottard . . . by incorporating the cationic polyurethane as taught by Laurent . . . to make such a composition.” *Id.* at 5. The Examiner attempts to support this conclusion by contending that “Cottard . . . as a primary reference clearly suggests the use of cationic polymers in a hair dyeing composition (see page 8, paragraph, 0167).” *Id.*

Applicants respectfully point out that the portion of Cottard cited by the Examiner to support his motivation argument merely states “Cationic Polymers,” which is not a disclosure that can be said to provide motivation to modify Cottard with the teachings of Laurent. *Id.* The Examiner also contends that Cottard “clearly suggests the use of associative cationic polymers such as quaternized cellulose in the dyeing composition.” Office Action at 4 (citing Cottard at page 5, paragraph [0099]). Applicants note that this

portion of Cottard cited by the Examiner actually teaches cationic polymers that do comprise, rather than "do not comprise," a C₈-C₃₀ fatty chain, and thus this section of Cottard teaches away from the present claims.

Applicants respectfully traverse this rejection because the Examiner has not established a prima facie case of obviousness. In order to establish a prima facie case of obviousness, the Examiner must meet three basic criteria, including the requirement that the cited reference or references must teach or suggest all of the claim limitations. See M.P.E.P. § 2143. As shown above, Cottard does not teach every element of the claimed composition. Laurent cannot cure the fact that Cottard does not teach at least the claimed elements of "b) at least one cationic associative polymer chosen from quaternized celluloses modified with groups comprising at least one fatty chain, quaternized hydroxyethylcelluloses modified with groups comprising at least one fatty chain and cationic polyurethanes, c) at least one nonionic cellulose-based compound not comprising a C₈-C₃₀ fatty chain, and d) at least one cationic polymer with a charge density of greater than 1 meq/g and not comprising a C₈-C₃₀ fatty chain."

Moreover, the disclosure of Cottard actually teaches away from the presently claimed invention in another respect as well. Cottard teaches a ready to use oxidation dye composition that remains on the hair, while avoiding the drawbacks of specific thickeners by, e.g. offering the hair good cosmetic properties such as chromatic shades and/or low selectivity. See Cottard at paragraphs [0005] to [0009]. Yet, some of the thickeners specifically mentioned by Cottard as impeding "a result of intense and chromatic shades of low selectivity and good fastness," include "hydroxyethylcelluloses [and] certain polyurethanes." See Cottard at paragraphs [0005] and [0006]. Since

hydroxyethylcelluloses are non ionic cellulose based compounds not comprising a C₈-C₃₀ fatty chain, i.e., as presently claimed, one of ordinary skill in the art could not possibly have been motivated to actually use such an ingredient after Cottard clearly taught away from it. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551 (Fed. Cir. 1994) (emphasis added). The Examiner cannot pick and choose from a reference only the teachings that suit his purpose. A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must also be considered. See *Bausch & Lomb, Inc. v. Barnes Hind/Hydrocurve, Inc.*, 796 F.2d 443 (Fed. Cir. 1986).

Accordingly, this rejection is in error and Applicants respectfully request its withdrawal.

B. Claims 48-49

The Examiner rejects claims 48-49 under 35 U.S.C. § 103(a) as allegedly "being unpatentable over Cottard. Office Action at 5-6. The Examiner admits that Cottard "does not teach the weight ratio between the nonionic polymers and associative polymers in the dyeing composition as claimed." *Id.* at 6. Despite this deficiency, the Examiner contends that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to formulate a dyeing composition comprising associative polymers and nonionic polymers with the claimed ratio." *Id.*

Applicants respectfully traverse this rejection because the Examiner has not established a prima facie case of obviousness. In order to establish a prima facie case

of obviousness, the Examiner must meet three basic criteria, including the requirement that the cited reference or references must teach or suggest all of the claim limitations. See M.P.E.P. § 2143. As shown above, Cottard does not teach every element of the claimed composition. Further, in order to support a rejection under 35 U.S.C. § 103, "the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d at 1357, 47 U.S.P.Q.2d at 1458 (Fed. Cir. 1998) (emphasis added).

The Examiner asserts that "the amounts of these polymers are within the claimed ranges, and, thus a person of the ordinary skill would expect such a composition to have a similar weight ratio between these polymers and would expect such a composition to have similar properties to those claimed, absent unexpected results." Office Action at 6. Applicants strongly disagree. There can be no motivation to modify the amounts of the polymers of Cottard to arrive at the present claims when Cottard does not teach the polymers recited in the claimed invention, let alone the provide the motivation to arrive at the presently claimed weight ratios.

The Examiner can satisfy the burden of establishing a prima facie case of obviousness "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to [modify or] combine the relevant teachings of the references." *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (citations omitted) (emphasis added).

Applicants submit that no such objective and specific evidence has been presented by the Examiner. Accordingly, the rejection of claims 48-49 is in error and Applicants request its withdrawal.

CONCLUSION


In view of the foregoing amendments and remarks, Applicants respectfully request reexamination of this application on the merits.

If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, he is respectfully invited to contact Applicants' undersigned counsel at 202-408-4368.

If there is any fee due in connection with the filing of this Preliminary Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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